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UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/506,434	02/18/2000	Ravi Acharya	47004.000059	8248

21967   7590   09/22/2006

HUNTON & WILLIAMS LLP
INTELLECTUAL PROPERTY DEPARTMENT
1900 K STREET, N.W.
SUITE 1200
WASHINGTON, DC 20006-1109

EXAMINER
COLBERT, ELLA

ART UNIT	PAPER NUMBER
3693	

DATE MAILED: 09/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>05 May 2006</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *15,17,21,55-58,64,65 and 68-76* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *15,17,21,55-58,64,65 and 68-76* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1.   Claims 1-76 are pending. Claims 1-4, 6-13, 16-19, 22-24, 27, 28, 30-54, 59-63,

66, and 67 have been withdrawn, Claims 5, 14, 20, 25, 26, and 29 have been cancelled

in response to the Election/Restriction filed 7/28/05. claims 15, 21, and 55 have been

amended in the response filed 05/05/06 entered as Non-Final Action, Petition, and

Request for Extension of Time. Claims 15, 17, 21, 55-58, 64, 65, and 68-76 are now

pending.

2.   The 35 USC 112 first paragraph rejection still remains for claims 15, 17, 21, 55-

58, 64, and 65 as set forth here below.

Claim Objections

3.   Claims 15, 21, and 55 are objected to because of the following informalities:

Claim 15 (a) recites "... through a customer terminal that is remotely situated with

respect ...; receiving transaction data that was entered into the customer terminals ...;".

These lines would be better recited as "... through a customer terminal remotely located

with respect ...; receiving transaction data entered into the customer terminals ...;".

Also, claim 15 n (c) recites "... the conventional check ...;". It is unclear what the "n"

stands for before "(c)". Further, step (d) recites "... a result of the transaction for each

conventional check". In steps (a) – (c) "the conventional check" is recited. Therefore,

step (d) would be better recited as "... a result of the transaction for the conventional

check". Claim 55 (c) has a similar problem.

        Claim 21 (a) and (c) recite "(a) receiving a request ... a terminal that is remotely

situated ..., wherein the terminal is remotely situated ..., wherein the bank customer ...;

(c) receiving transaction data that is entered into the terminal ..., ...;". These lines

would be better recited as "(a) receiving a request ... a terminal remotely located ...,

wherein the terminal is remotely located ..., wherein the bank customer ...; (c)

receiving transaction data entered into the terminal ..., ...;".

Claim 55, the preamble recites "A computerized method for allowing a bank

customer to deposit ... from a location that is remotely situated with respect to a bank,

comprising:". These lines would be better recited as "A computerized method for

allowing a bank customer to deposit ... from a remotely located location with respect to

a bank, comprising:". Claim 55 (d) recites "processing the discrete value of each check

for deposit ... of the conventional check by the automated banking system; and (e)

receiving a result of the transaction for each check." The preamble recites

"conventional checks" and the body or the claim recites in (c) – (e) "conventional check"

and "each check". These limitations would be better recited as "conventional checks"

and "each of the checks". Appropriate correction is required.

Claim Rejections - 35 USC § 112

4.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5.   Claims 15, 17, 21, 55-58, 64, 65, and 68-76 are rejected under 35 U.S.C. 112,

first paragraph, as failing to comply with the enablement requirement. The claim(s)

contains subject matter which was not described in the specification in such a way as to

enable one skilled in the art to which it pertains, or with which it is most nearly

connected, to make and/or use the invention. It is unclear in the Specification that the

ACH and automated banking system do not receive the physical check and this is the

reason for the 35 U.S.C. 112, first paragraph rejection.

Claim Rejections - 35 USC § 103

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

7.   Claims 15, 17, and 55 are rejected under 35 U.S.C. 103(a) as being

unpatentable over (US 5,933,816) Zeanah et al, hereafter Zeanah in view of (US

6,912,048) Gustin et al, hereafter Gustin, (US 5,819,236) Josephson in view of (US

5,930,778) Geer.

As per claim 15, A computerized method for allowing a bank customer to deposit

the value of conventional checks into a bank account from a location that is remotely

situated with respect to a bank comprising: Zeanah discloses, (a) logging a bank

customer payee onto an automated banking system through a customer terminal that is

remotely situated with respect to a bank and the automated banking system, wherein

the bank customer payee is the recipient of a conventional check payable to the bank

customer payee (col. 9, lines 28-52, col. 12, lines 13-40, col. 13, lines 42-63, and col.

20, lines 29-39). Customer terminals are located in shopping malls, grocery stores, gas

stations, and on-line banking which are remotely located from the bank. It is well known

that a customer has to logon to a banking system to conduct any type of transaction. In this case, cashing or depositing a conventional check made to the bank customer. Also Gustin discloses, (a) logging a bank customer payee onto an automated banking system through a customer terminal that is remotely situated with respect to a bank and the automated banking system, wherein the bank customer payee is the recipient of a conventional check payable to the bank customer payee (Fig. 8 (300, 302, 304, 306, 308, 310, and 316), and Fig. 8A –8C). Zeanah failed to disclose, (b) receiving transaction data that was entered into the customer terminal by the bank customer payee, wherein the transaction data comprises routing number, account number, date written and amount of the conventional check. Gustin discloses (b) receiving transaction data that was entered into the customer terminal by the bank customer payee, wherein the transaction data comprises routing number, account number, date written and amount of the conventional check (Fig. 19, 19A –19D and col. 18, line 55-col. 19, line 26). Zeanah and Gustin failed to disclose (e) receiving by the bank customer a result of the transaction for each check. Josephson discloses, (e) receiving by the bank customer a result of the transaction for each check (col. 8, lines 34-40 and lines 49-57).

Josephson failed to disclose, (c) processing the discrete value of the conventional check for deposit by the automated banking system without physical receipt of the conventional check by the automated banking system. Geer discloses, (c) processing the discrete value of the conventional check for deposit by the automated banking system without physical receipt of the conventional check by the automated banking system (col. 6, lines 40- col. 7, line 61 and col. 8, lines 1-27). It would have

been obvious to one having ordinary skill in the art at the time the invention was made

to process the discrete value of the conventional check for deposit by the automated

banking system without physical receipt of the conventional check by the automated

banking system and to modify in Josephson because such a modification would allow

Josephson to not have physical paper checks transported from the bank customer's

location and to have the information from the checks extracted and converted into

electronic form.

As per claim 17, Zeanah failed to disclose, The method of claim 15 wherein the

result of the transaction in step (d) comprises a provisional credit to the bank customer

payee's account. Josephson discloses, The method of claim 15 wherein the result of the

transaction in step (d) comprises a provisional credit to the bank customer payee's

account (col. 10, lines 17-25).

As per claim 55, this independent claim is rejected for the similar rationale as

given above for claim 15.

Claim Rejections - 35 USC § 103

8.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

9.   Claims 21, 56- 58, 64, and 65 are rejected under 35 U.S.C. 103(a) as being

unpatentable over (US 5,819,236) Josephson and (US 6,012,048) Gustin et al, Gustin

and in view of (US (US 5,930,778) Geer.

As per claim 21, Josephson discloses, A computerized method for allowing a

bank to process check deposit transactions that are initiated by a bank customer at a

remote location comprising: (a) receiving a request from a bank customer payee who

enters the request through a terminal that is remotely situated from a bank for

authorization to make a transaction using an automated banking system, wherein the

terminal is remotely situated from the automated banking system, wherein the bank

customer payee is the recipient of a conventional check payable to the bank customer

(col. 4, lines 56-65 and col. 5, lines 26-63 and fig. 1).

Josephson failed to disclose (b) authorizing the bank customer payee as a user

on the automated banking system and (c) receiving transaction data that is entered into

the terminal by the bank customer payee, wherein the transaction data is related to the

deposit of the conventional check, where the payor of the conventional check is

someone other than the bank customer payee. Gustin discloses, authorizing a bank

customer payee as a user on the automated banking system (fig. 8 (300, 308, & 310),

fig. 8A, and 8B –shows authorizing a customer payee as a user of the automated

banking system)); and (c) receiving transaction data that is entered into the terminal by

the bank customer payee, wherein the transaction data is related to the deposit of the

conventional check, where the payor of the conventional check is someone other than

the bank customer (col. 12, lines 3-47, col. 19, line 56 –col. 20, line 63, Fig. 13 E, Fig.

13 F, fig. 20, fig. 20A, Fig. 20B, fig. 20C, Fig,. 20E, and Fig. 20F). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Josephson because such a modification would allow Josephson to have the payment accepted for each check for the amount of the face value (amount written on the face of the check). Josephson failed to disclose, (d) processing the transaction for the discrete value of the check without physical receipt of the conventional check by the automated banking system. Geer discloses, (d) processing the discrete value of the check for deposit by the automated banking system without physical receipt of the conventional check by the automated banking system (col. 6, lines 40- col. 7, line 61 and col. 8, lines 1-27). It would have been obvious to one having ordinary skill in the art at the time the invention was made to process the discrete value of the check for deposit by the automated banking system without physical receipt of the conventional check by the automated banking system and to modify in Josephson because such a modification would allow Josephson to not have physical paper checks transported from the bank customer's location and to have the information from the checks extracted and converted into electronic form.

As per claim 56, Josephson failed to disclose, The method of claim 55, wherein the customer terminal comprises a digital image scanner comprising optical recognition software capable of converting machine printed characters to electronic text. Geer discloses, wherein the customer terminal comprises a digital image scanner comprising optical recognition software capable of converting machine printed characters to electronic text (col. 7, lines 37-67). It would have been obvious to one having ordinary

skill in the art at the time the invention was made to have the customer terminal comprise a digital image scanner comprising optical recognition software capable of converting machine printed characters to electronic text and to modify in Josephson because such a modification would allow Josephson to have the capability to have the data from the check scanned by an electronic scanner and sent through the banking system without depositing the check.

As per claim 57, Josephson discloses, The method of claim 56, wherein entering transaction data into the customer terminal comprises scanning the checks using the digital image scanner (col. 4, lines 3-23).

As per claim 58, Josephson discloses, The method of claim 55, wherein the result of the transaction in (e) comprises a provisional credit to the associated demand deposit account (col. 10, lines 17-25).

As per claim 64, Josephson failed to disclose, further comprising (f) optionally subjection each conventional check to one or more actions to prevent redeposit of the conventional check. Geer discloses, further comprising (f) optionally subjection each conventional check to one or more actions to prevent redeposit of the conventional check (col. 8, lines 22-35). It would have been obvious to one having ordinary skill in the art at the time the invention was made to optionally subjection each conventional check to one or more actions to prevent redeposit of the conventional check and to modify in Josephson because such a modification would allow Josephson to prevent duplicated deposits of the same check for reconciliation of the customer's bank account.

As per claim 65, Josephson failed to disclose, wherein the one or more actions comprise marking each conventional check by human or machine readable ink, physical capture of each conventional check or combinations thereof. Geer discloses, wherein the one or more actions comprise marking each conventional check by human or machine readable ink, physical capture of each conventional check or combinations thereof (col. 7, lines 4-67). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the one or more actions comprise marking each conventional check by human or machine readable ink, physical capture of each conventional check or combinations thereof and to modify in Josephson because such a modification would allow Josephson to have the check scanned by a suitable reader with the amount of the check and date being optionally verified by a human operator and included in the electronic record to be associated with each check.

As per claims 68, 71, and 74, Josephson discloses, wherein entering transaction data into the customer terminal comprises entering transaction data via a magnetic ink character reader or a digital image scanner (col. 4, lines 47-55).

As per claims 69, 73, and 75, Josephson discloses, wherein the digital image scanner comprises optical recognition software to convert machine printed characters to electronic text (col. 8, lines 12-29).

As per claims 70, 72, and 76, Josephson failed to disclose, wherein the digital image scanner comprises intelligent character recognition software to convert handwritten characters to electronic text. Geer discloses, wherein the digital image

scanner comprises intelligent character recognition software to convert handwritten

characters to electronic text (col. 7, lines 26-61).

Response to Arguments

10.   Applicants' arguments filed 07/28/06 have been fully considered but they are not

persuasive. The below issues and arguments are the main issues and arguments as the

best the Examiner can determine.

Issue no. 1: Applicants' argue: Applicants' respectfully submit that the 35 USC

112 first paragraph rejection for claims 1, 4, 6, 10, 11, 13, 15, 17, 21, and 50-67 should

be withdrawn because the Examiner has not met the burden of establishing a

reasonable basis to question the enablement provided for the claimed invention has

been considered but is not deemed persuasive. Response: The 35 USC 112 first

paragraph requirement has been withdrawn for claims 1, 4, 6, 10, and 11 but still

remains for claims 15, 17, 21, 55-58, 64, 65, and newly added claims 68-76. Claims 15,

17, 21, 55-58, 64, 65, and newly added claims 68-76 rejected under 35 U.S.C. 112, first

paragraph, as failing to comply with the enablement requirement. The claim(s) contains

subject matter which was not described in the specification in such a way as to enable

one skilled in the art to which it pertains, or with which it is most nearly connected, to

make and/or use the invention. It is unclear in the Specification and in the drawings

that the ACH and automated banking system do not receive the physical check and this

is the reason for the 35 U.S.C. 112, first paragraph rejection. Claim 15 (c) recites

processing the discrete value of the conventional check for deposit by the automated

banking system without physical receipt of the conventional check by the automated

banking system". It is unclear in the Specification and drawings how this claim limitation takes place without the ACH and automated banking system receiving the physical check by the automated banking system at some point during the transaction and crediting to the customer account process. Given the broadest reasonable interpretation the check is deposited through an on-line banking environment by simply logging into the system and entering the routing information, the amount of the deposit, an electronic signature, etc.. Nothing in Applicants' claims discloses or suggests that actions are taken to prevent "re-deposit of the same check". According to the discussion on page 14, the check does go through a clearing process. This process is like the copy of the scanned paper checks that I receive from my bank each month with my bank account statement. The deposit of the check amount is an electronic deposit without involving a paper check except for a scanned copy of the paper check and a mark or watermark.

Issue no. 2: Applicants' discuss the Restriction Requirement on page 17 of the Response dated 07/28/05. Applicants' election of claims 15, 17, 21, 55-58, 64, and 65 including new claims 68-76 are acknowledged and were examined on the merits.

Conclusion: The claim limitations of claim 15 (a) – (c) and (e) are all well known and take place when depositing a check along with the other claims 17, 21 (a) –(c), 55 (a)- (c) and (e), 56-58, 64, 65, and 68-76. Claims 15 (d), 21 (d), and 55 (d) are questionable until clarification of how the conventional check is deposited by an automated banking system without ever physically receiving the conventional check by

the automated banking system and without the ACH receiving the physical check is made in the specification and/or drawings.

Conclusion

10.   Applicants' amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Inquiries

11.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Monday, Tuesday, and Thursday, 5:30AM-3:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

September 4, 2006

ELLA COLBERT
PRIMARY EXAMINER